

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

HEADWATER RESEARCH LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Civil Action No. 2:23-cv-00103-JRG-RSP

JURY DEMANDED

JOINT MOTION FOR ENTRY OF DISPUTED PROTECTIVE ORDER

Pursuant to the Court’s Order setting a deadline to file a proposed Protective Order (D.I. 41), Plaintiff Headwater Research, LLC (“Headwater”) and Defendants Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Defendants” or “Samsung”), (collectively, the “Parties”) hereby submit competing forms of the Proposed Protective Order. The parties’ proposals are attached as **Exhibit A** (Headwater) and **Exhibit B** (Samsung).

The parties agree on almost all provisions of the Protective Order, but disagree on how the scope of the prosecution bar therein is defined.

Plaintiff’s Position:

Headwater’s proposal follows not only this Court’s model protective order but also the protective order language agreed upon in Case No. 2:22-cv-00422-JRG-RSP (“the -422 Action”), which involves the exact same parties and counsel as the present action. Samsung provides no justification for departing from the Court’s default language and what Samsung agreed to only a few months ago in another Headwater case. Samsung’s specific proposal is also problematic because, if anything, it seeks to improperly broaden the scope of the prosecution bar and would not prevent future disputes in any event.

Paragraph 11 of this Court’s model protective order uses the exact same language that Headwater’s proposal does, limiting the scope of the prosecution bar to “the field of the invention of the patents-in-suit.” *See* E.D. Texas Sample Protective Order for Patent Cases ¶ 11. This language is understandable to all parties and this Court. Indeed, it is the default language that has been applied by this Court for years in hundreds, if not thousands, of protective orders. Samsung offers no legitimate reason for deviating from this default language here.

Indeed, the same parties and counsel agreed to include this exact language in the protective order entered in the -422 Action only six months ago. *See* Case No. 2:22-cv-00422-JRG-RSP, Dkt. No. 55 at 13 (E.D. Tex. Apr. 5, 2023). Samsung has not identified anything that has occurred in that case or this one suggesting that such language is now suddenly problematic. The same parties and counsel agreeing to use the Court’s default language a few months ago only further demonstrates that there is no reason to deviate now.

During the parties’ telephonic meet-and-confer, counsel for Headwater pointed out not only these facts but also problems with Samsung’s specific proposed language. Samsung proposes replacing the default language “the field of the invention of the patents-in-suit” with “the fields of invention of the patents in suit (*e.g.*, transmission of messages between a server and an application using encryption, network message servers, and message link servers).” *See* Ex. B (Samsung’s Proposed PO) ¶ 11. To generate its proposed language, it appears that Samsung cobbled together a few individual words or phrases from three different patent abstracts. That is not a reasonable way to define the scope of the prosecution bar here. As one example, one might read Samsung’s proposal to encompass all technologies involving communication between a device and a server, which would be unreasonably overbroad. And given the lack of clarity in Samsung’s proposal, adopting Samsung’s proposed additional language would not avoid future disputes about the scope

of the prosecution bar. If any such dispute were to arise later (and Headwater certainly expects none), the parties and the Court could simply resolve that dispute by using the default protective order language that is routinely applied by this Court (and does not include Samsung's additional parenthetical)—which also governs the same parties and counsel in the -422 Action case involving other Headwater patents.

Accordingly, Headwater respectfully requests that its proposed protective order be adopted, consistent with this Court's default protective order.

Defendants' Position:

A prosecution bar, which both parties agree is appropriate here, protects Samsung's confidential information from misuse. The "field of the invention," in turn, plays a key role in defining the scope of that protection. Samsung has proposed fields of invention for each of the three asserted patents that are consistent with the subject matter of the asserted patents. Headwater objects to Samsung's proposed language, yet has failed to propose any alternative or identify specific issues in Samsung's proposed language, despite repeated requests by Samsung. Headwater complains that Samsung's proposal is broad, but fails to identify how or why or even offer a counter proposal. Headwater also alleges, without explanation, that future disputes regarding the definition of "field of the invention" would be better resolved if the parties kick the can down the road. But if any disputes were to arise, the Court and the parties would be better served by having pre-defined fields of inventions by which to weigh any alleged violation of the prosecution bar.

Headwater argues that the generic recitation of "field of the invention" "is understandable to all parties" but, as this dispute clearly shows, the parties have differing views of what the fields of invention are for each patent. Unlike the -422 Action—in which no dispute has arisen—here,

a known dispute exists, it should be resolved before Headwater receives confidential information. Moreover, given that Headwater disputes Samsung's language but provides no alternative, Samsung cannot determine how Headwater intends to interpret the scope of the prosecution bar going forward, further increasing uncertainty and the risk of misuse, even if inadvertent.

The field of the invention plays a key role in defining the scope of the prosecution bar and protecting Samsung's information. "In determining the scope of a prosecution bar, the relevant question is . . . in which fields the patented technology could reasonably be used, i.e. the areas of technology where there is a risk that individuals may inadvertently exploit their new knowledge in future patent prosecution." *E-Contact Techs., LLC v. Apple, Inc.*, No. 1:11-CV-426 LED/KFG, 2012 WL 11924448, at *2 (E.D. Tex. June 19, 2012); *see also Visto Corp. v. Seven Networks, Inc.*, No. 2:03-CV-333-TJW, 2006 WL 3741891, at *5 (E.D. Tex. Dec. 19, 2006) ("The purpose for this provision is plain—it is to allow discovery in the case to move forward and to prevent a party from using its opponent's confidential technical and financial information for purposes other than the prosecution or defense of the lawsuit.").

Courts routinely define broad "fields of the invention" in prosecution bars found in protective orders. *See E-Contact Techs.*, 2012 WL 11924448 at *3 (adopting defendant's broader definition and finding that "[i]t is necessary to impose a broader prosecution bar to protect Defendants' confidential information which will be exchanged in this case"); *see also Arigna Tech. Ltd. v. Google LLC*, No. 21-cv-01045-ADA, ECF No. 37 (W.D. Tex. Apr. 12, 2022); *Free Stream Media Corp. v. Alphonso Inc.*, No. 15-cv-01725, ECF No. 82 (E.D. Tex. Oct. 5, 2016); *PaR Sys. Inc. v. iPHOTON SOLS., LLC*, No. 10-cv-00393, ECF No. 53 (N.D. Tex. Aug. 23, 2010). This makes sense. Now that a dispute exists, the "field of the invention" can and should be determined

before Headwater has access to Samsung confidential information. Indeed, defining the “field of the invention” *before* Headwater receives Samsung’s confidential information eliminates the risk that Headwater “may inadvertently exploit their new knowledge” by later defining the “field of the invention” based on Samsung’s confidential information. *E-Contact Techs.*, 2012 WL 11924448 at *2. Additionally, specifying the “field of the invention” in the protective order provides clarity to all parties and counsel regarding the bounds of the protective order and minimizes future disputes regarding protective order violations.

Thus, Samsung requests that the Court adopt Samsung’s prosecution bar provision.

Dated: October 27, 2023

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served this 27th day of October 2023, with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Marc Fenster

Marc Fenster

CERTIFICATE OF CONFERENCE

The undersigned certifies that counsel met and conferred multiple times per Eastern District of Texas Local Rule CV-7(h) and were able to resolve most of their disputes, but the dispute identified above still remains. The parties are in agreement on filing this Joint Motion.

/s/ *Kristopher Davis*

Kristopher Davis